



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,652	11/18/2003	Edgardo Laborde	25352-0033D1	7687

25213 7590 07/09/2004

HELLER EHRMAN WHITE & MCAULIFFE LLP  
275 MIDDLEFIELD ROAD  
MENLO PARK, CA 94025-3506

EXAMINER
----------

DENTZ, BERNARD I

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,652	<b>Applicant(s)</b> LABORDE ET AL.	
	<b>Examiner</b> Bernard Dentz	<b>Art Unit</b> 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1625

Applicants must provide the Examiner with a copy of all of the non-patent references that they cite. The Examiner does not have them even though they were filed in the parent case.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1,2,5,6,9,15,16 and 20-38, drawn to compounds of formula I, classified in class 549, subclass 436 e.g..
- II. Claims 1,3-5,7,8,12,13,20,21 and 25-38, drawn to compounds of formulae II and III which contain 1 hetero atom in the ring W-X-Y, classified in class 548, subclass 503 e.g.
- III. Claims 1,3-5,7,8,14,19-21,25-29,31,32 and 34-38, drawn to compounds of formulae II and III which contain 3 hetero atoms in ring W-X-Y, classified in class 548, subclass 261 e.g.
- IV. Claims 39-43, drawn to pharmaceutical methods of treatment using the Gp. I cpds., classified in class 514, subclass 465.
- V. Claims 39-43, drawn to pharmaceutical methods of treatment using the Gp. II cpds., classified in class 514, subclass 415.
- VI. Claims 39-43, drawn to pharmaceutical methods of treatment using the Gp. III cpds., classified in class 514, subclass 359.

The inventions are distinct, each from the other because: Markush claim 1 encompasses a huge territory in the realm of aroylureas. The aryl part of the aroyl moiety encompasses bicyclic moieties with great variety of hetero atom combinations in the 5-membered ring part. The 6 membered ring part can be phenyl or pyridine. The 5

Art Unit: 1625

membered ring may be saturated or unsaturated. The method of use claims covers a huge area of diseases.

Thus because of the above and because the searches are not co-extensive, restriction as above is proper.

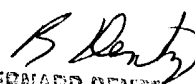
If one of the compound Groups is elected a single disclosed species must be elected in case no generic claim is found allowable. Likewise if 1 of the method of use Groups is elected a single disclosed and enabled disease must be elected in case no generic claim is found allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dentz  
7-8-2004

  
BERNARD DENTZ  
PRIMARY EXAMINER  
GROUP 1630